

REMARKS

Claims 1-18 are pending in the present application. Claims 1 and 10 have been amended to direct the claims to the elected SEQ ID NO. required by the Restriction Requirement. Applicants reserve the right to prosecute the non-elected subject matter in one or more related applications. Applicants reserve the right to petition from the Restriction Requirement under 37 C.F.R. § 1.144. No new matter has been added.

I. Restriction Requirement

In the present Office Action, the Examiner required restriction of the claims based on the SEQ ID NO's. recited in the claims. The Examiner states that the Applicants are required to elect a single oligonucleotide SEQ ID NO. from claims 1 and 10. In response, Applicants hereby elect the XIAP oligonucleotide SEQ ID NO: 29 for continued examination and prosecution on the merits, *with traverse*.

The Examiner relies on MPEP § 806.04, and MPEP § 808.01 to assert that the inventions are unrelated and that in the instant case the oligonucleotides and methods comprising them are biologically, structurally and functionally different and distinct from each other. Moreover, the Examiner asserts that searching the inventions of groups comprising all of these different oligonucleotide molecules and the methods comprising them together would impose a serious search burden. The Examiner also states that the inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects.

Applicants respectfully submit that the Examiner has improperly restricted the claims based on SEQ ID NO's. Applicants wish to direct the Examiner to MPEP §803.04 and §2434 which set forth the policy of the USPTO regarding examination of nucleotide sequences. The following is a quotation of MPEP §803.04 (emphasis added):

"...normally ten [nucleotide] sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a

single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct invention and will continue to be examined together."

Applicants submit that this policy should be applied to the present claims for the following reasons. Claims 1-18 specifically claim oligonucleotide sequences which target and inhibit the expression of inhibitor of apoptosis proteins (IAP). As illustrated in Table 1 in the specification, the oligonucleotides SEQ ID NO's. 1-96 specifically target XIAP, whereas in Table 2 the antisense oligonucleotides specifically target HIAP 1. The Examiner's attention is drawn to pages 43-47 at the specification in which 10 XIAP oligonucleotides, namely E2 (SEQ ID NO: 13), E3 (SEQ ID NO: 21), F3 (SEQ ID NO: 22), E4 (SEQ ID NO: 29), F4 (SEQ ID NO: 30), G4 (SEQ ID NO: 31), C5 (SEQ ID NO: 35), B6 (SEQ ID NO: 42), D7 (SEQ ID NO: 52) and F8 (SEQ ID NO: 63), demonstrated a consistent ability to decrease XIAP protein or RNA levels. It is Applicants position that the aforesaid sequences are capable of use together, and that they have the same modes of operation, same functions and same effects. Thus, at the very least in the instant case the oligonucleotides and methods comprising them are biologically and functionally the same as each other.

In view of the relatedness of the sequences, it is Applicant's position that a search and examination of the aforesaid 10 sequences would be coextensive and therefore would not place an undue burden of search on the examiner. If the restriction requirement is maintained, Applicants respectfully request that it be modified such that the 10 SEQ ID NOs: 13, 21, 22, 29, 30, 31, 35, 42, 52 and 63, be examined together on their merits.

Applicants point out that if they are forced to file several divisional applications, such divisional applications would incur additional expenses and a shorter patent term than if all the claims were examined in this application together. In view of the foregoing, Applicants respectfully request that the Examiner modify the restriction requirement to include the aforesaid ten SEQ ID NO's.


II. Attorney docket number

The attorney docket number for this case has changed to **L80003221US**. It is respectfully requested that the Examiner now use this number on all correspondence associated with this case.

In view of the above amendments and remarks, Applicants respectfully submit that application is now in condition for an early examination and earnestly request such action. It is not believed that any fee is due. However, the Commissioner is hereby authorized to charge any fees that may be required and to credit any overpayment to Deposit Account No. 501644. If any points remain at issue which can be best result by way of a telephone or personal interview the Examiner is kindly requested to contact the undersigned agent at the telephone number listed below.

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Respectfully submitted.


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